

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GREGORY WINFIELD GORMAN

Appeal 2008-3767
Application 10/633,943
Technology Center 1700

Decided: September 23, 2008

Before BRADLEY R. GARRIS, CHUNG K. PAK, and
JEFFREY T. SMITH, *Administrative Patent Judges*.

GARRIS, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant appeals under 35 U.S.C. § 134 from the Examiner's decision rejecting claims 1-11 and 28-34.¹ We have jurisdiction under 35 U.S.C. § 6.

¹ Appellant states that "it is not clear whether claims 12-19 and 35 have been cancelled or not" and "respectfully requests that this case be remanded to the Examiner for preparation of a new, non-final Office Action, so that these issues may be resolved". (Reply Br. 37). We will not grant this request because (1) claims 12-19 and 35 are not on appeal (App. Br. 3) and accordingly their status is

We AFFIRM.

Appellant claims a pavement tape comprising an elongated flexible tape body configured for affixing to pavement and having at least one information-conveying symbol printed on the front face of the tape body.

Further details concerning this claim subject matter are set forth in representative independent claims 1, 9, and 10 which read as follows:

1. A pavement tape for conveying information when affixed to pavement, said pavement tape comprising a continuous elongated flexible tape body of homogeneous composition, said tape body configured for affixing to pavement and comprising a front face and a continuously flat rear face, wherein at least one symbol printed upon said front face conveys information, and wherein the front and rear faces are exposed at an end of the continuous elongated flexible tape body.

9. A pavement tape for conveying information when affixed to pavement, said pavement tape comprising a continuous elongated flexible tape body comprising front and rear faces, said front face comprising at least one symbol that conveys information, the at least one symbol formed as a perforation extending at least partly from said front face to said rear face of said tape body, wherein the front and rear faces are exposed at an end of the continuous elongated flexible tape body.

10. A pavement tape for conveying information when affixed to pavement, said pavement tape comprising:

an elongated flexible tape body comprising front and rear faces, said front face comprising at least one symbol that conveys information; and

a mask tape, said mask tape comprising a flexible mask tape body having front and rear mask faces and at least one symbol formed as a perforation

irrelevant to our deposition of the appeal and (2) the electronic file record for this application indicates that Appellant cancelled these claims in a paper filed Feb. 24, 2006.

extending from said front mask face to said rear mask face, said rear mask face of said mask tape being bonded to said front face of said pavement tape.

The references set forth below are relied upon by the Examiner as evidence of unpatentability:

Bastiaens	6,514,655 B2	Feb. 4, 2003
Cabrera	6,576,074 B1	Jun. 10, 2003
Jacobs	US 2003/0123930 A1	Jul. 3, 2003

Claims 1-8, 11, and 28-34 are rejected under the first paragraph of 35 U.S.C. § 112 for failing to comply with the written description requirement.

Claims 1-5, 7, 8, 11, 28-32, and 34 are rejected under 35 U.S.C. § 102(e) as being anticipated by Bastiaens.

Claim 9 is rejected under 35 U.S.C. § 102(e) as being anticipated by Cabrera.

Claim 10 is rejected under 35 U.S.C. § 102(e) as being anticipated by Jacobs.

Finally, claims 6 and 33 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Bastiaens.

For the reasons which follow, we will not sustain the § 102 and § 103 rejections based on Bastiaens, but we will sustain the remaining rejections before us in this appeal.

The § 112, first paragraph, rejection of claims 1-8, 11, and 28-34

According to the Examiner, the phrase "homogeneous composition" of independent claims 1 and 28 is not descriptively supported by Appellant's originally filed disclosure (Ans. 3-4). In response, Appellant argues that the

claim phrase is disclosed in Figures 5-13 of the originally filed drawing disclosure (App. Br. 9-13; Reply Br. 5-6).

To comply with the written description requirement in the first paragraph of § 112, an original disclosure must convey, with reasonable clarity to those skilled in the art, that the applicant, as of the filing date sought, was in possession of the claimed invention. *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64 (Fed. Cir. 1991). Drawings alone may, under proper circumstances, provide the written description required by § 112. *Id.*, 935 F.2d at 1564-65.

Contrary to Appellant's argument, Figures 5-13 of the drawing do not provide written description of the "homogeneous composition" aspect of the invention defined by the rejected claims. Figure 5 is representative of these figures and is reproduced below.

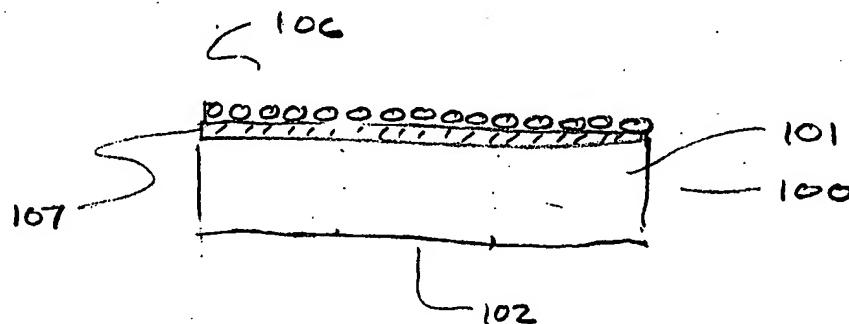


FIG 5.

Figure 5 depicts an end view of Appellant's pavement tape.

This figure depicts tape body 101 as an unembellished rectangular shaped box. Such a depiction discloses nothing about the composition of the tape body and therefore does not provide a written description of Appellant's claim requirement that the tape body be of "homogeneous composition" (Independent

claims 1, 28). The other drawing figures referred to by Appellant (i.e., Figures 6-13) are similarly deficient.

Under these circumstances, we sustain the Examiner's § 112, first paragraph, rejection of claims 1-8, 11, and 28-34.

The § 102 and § 103 rejections of claims 1-8, 11, and 28-34 based on Bastiaens

For each of these rejections, the Examiner takes the position that element 30 of Bastiaens' Figure 2 embodiment satisfies the claim requirement "a continuous elongated flexible tape body of homogeneous composition" (Independent claims 1, 28) (Ans. 8). Specifically, the Examiner states "Bastiaens, in col. 4, lines 6-7, mentions that the body (30) has microspheres dispersed uniformly throughout the body indicating that the body has uniform composition" (*id.*). In the alternative, the Examiner finds that "the presence of additional elements in [the] homogeneous composition of the body (30) in Bastiaens is not precluded by the open language [i.e., "comprising"] in said instant claims 1 or 28" (*id.*).

The Examiner committed error in finding that Bastiaens discloses that microspheres are "dispersed uniformly throughout the body [i.e., binder layer 30]" at lines 6-7 of column 4 (*id.*). In fact, patentee discloses merely that "[t]he glass microspheres are dispersed throughout the binder layer" (col. 4, ll. 6-7) with no disclosure of the dispersal being uniform. Regardless, a uniform dispersal of microspheres throughout binder layer 30 would not indicate "that the body has uniform composition" (Ans. 8) as the Examiner believes. The term "homogeneous" means "consisting of parts all of the same kind" (*Concise Oxford*

American Dictionary 2006) whereas Bastiaens' binder layer and microspheres are not parts all of the same kind.

The Examiner also committed error in finding that the open term "comprising" would permit inclusion of differing materials (e.g., the microspheres of Bastiaens) in the "homogeneous composition" of independent claims 1 and 28. The claim term "comprising" cannot be interpreted as defeating the express claim limitation "homogeneous composition." On its face, such an interpretation is unreasonable. *See In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004) (claims should be given their broadest reasonable interpretation consistent with the specification).

For the above stated reasons, we do not sustain the § 102 and § 103 rejections based on Bastiaens of claims 1-8, 11, and 28-34.

The § 102 rejection of claim 9 based on Cabrera

The Examiner finds that Cabrera's Figure 2 pavement marking system includes pre-cut orifices 14 (col. 3, ll. 15-35, col. 4, ll. 25-30), thereby satisfying the claim 9 requirement of a pavement tape comprising a tape body having a symbol formed as a perforation (Ans. 5, 9-10).

Appellant argues that "the likelihood of [Cabrera's] orifice 14 'conveying information' is slim to none [because] [i]t is highly unlikely that an orifice in a black background layer, through which black-treated asphalt is visible, would successfully convey any information" (App. Br. 30). This argument is speculative, lacks evidentiary support, and is based on assumptions (i.e., a black background layer or pavement tape being placed on a black asphalt pavement)

which are equally applicable to the claim 9 pavement tape and the Cabrera pavement marking system. For these reasons, the argument is unpersuasive.

Appellant also argues that the HOTape®, which can be used by Cabrera as the background layer, "is widely recognized as a thermoplastic material, which must be heated in place [and which] . . . is different from Appellant's tape [as described in paragraph [0069] of the specification]" (App. Br. para. bridging 30-31). However, Appellant identifies no recitation in claim 9 which distinguishes the tape defined thereby from the HOTape® of Cabrera. Similarly, Appellant does not explain why the claim 9 tape must be interpreted as a pressure sensitive adhesive tape of the type described in Specification paragraph [0069]. To the contrary, Specification paragraph [0062] makes clear that the "pavement [tape] adhesive 111 may be any one of a number of types of adhesive," thereby suggesting the use of adhesives other than the pressure sensitive adhesive of paragraph [0069]. On this record, such other adhesives appear to include the adhesive of Cabrera's HOTape®. Under these circumstances, it would be improper to read the adhesive limitations of paragraph [0069] into claim 9 as urged by Appellant. *See In re Acad. of Sci. Tech. Ctr.*, 367 F.3d at 1369.

In light of the foregoing, Appellant has failed to show error in the Examiner's finding that claim 9 is anticipated by Cabrera. Therefore, we sustain the § 102 rejection of this claim based on Cabrera.

The § 102 rejection of claim 10 based on Jacobs

Jacobs discloses a pavement marker comprising an array of magnetic pavement elements 24 connected to carrier web 22 via frangible connection 32 (which is formed by die-cutting) wherein adhesive 26 and release liner 30 are

disposed at the bottom surface of the pavement marker (Fig., 1; paras. [0044]-[0045]). The Examiner finds that Jacobs' pavement marker anticipates the claim 10 pavement tape. More specifically, the Examiner finds that Jacobs' release liner 30 comprising the depressions formed therein (i.e., which contain adhesive 26) correspond to the claim 10 tape body comprising at least one information-conveying symbol, that Jacobs' magnetic elements 24 plus carrier web 22 correspond to the claim 10 mask tape body, and finally that Jacobs' die-cut frangible connection 32 corresponds to the claim 10 symbol formed as a perforation in the mask tape body (Ans. 5-6, 10-11).

Appellant argues, without embellishment, that Jacobs' release liner 30 "is clearly different from a pavement tape" (App. Br. 33; Reply Br. 32). For a number of reasons, we perceive no convincing merit in this argument.

First, the argument misinterprets claim 10, the application of Jacobs against claim 10, or both. By way of clarification, the pavement tape of claim 10 comprises (1) a tape body and (2) a mask tape which the Examiner respectively equates to Jacobs' pavement marker comprising (1) release liner 30 and (2) the magnetic pavement elements 24 plus carrier web 22. Thus, it is the pavement tape body of claim 10 which the Examiner equates to Jacobs' release liner 30.

Second, the argument does not explain why the pavement tape body defined by claim 10 is believed by Appellant to differ from Jacobs' release liner 30. On the other hand, this belief is inconsistent with the fact that the shape and dimension of Jacobs' release liner 30 corresponds to the shape and dimension of Appellant's tape body 101 as depicted in, for example, Figure 2. Likewise, Appellant's belief is inconsistent with the fact that release liner 30 falls within the

common definition of "tape" (i.e., "a narrow, flexible, continuous strip of material"; *Webster's II New Riverside University Dictionary* 1984).

Appellant further argues that Jacobs' frangible connection 32 is not a symbol formed as a perforation as required by claim 10 (App. Br. 33; Reply Br. 33). We do not agree.

As explained above, frangible connection 32 is formed by die cutting (para. [0045]) and accordingly is formed as a perforation. Moreover, we do not perceive and Appellant does not explain why the Examiner has erred in finding the claim 10 "at least one symbol formed as a perforation" to be anticipated by the lines formed via the die-cut perforations of Jacobs' frangible connections 32 (*see* Jacobs' Figure 1). To the contrary, the Examiner's finding is supported by Appellant's disclosure that the inventive symbols "may be any know symbols" (Spec. para. [0048]) including "non-language symbols" (Spec. para. [0050]).

Because Appellant has failed to identify any error in the Examiner's anticipation finding, we sustain the § 102 rejection of claim 10 based on Jacobs.

Summary

The decision of the Examiner is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

cam

Appeal 2008-3767
Application 10/633,943

LATHROP & GAGE LC
4845 PEARL EAST CIRCLE
SUITE 300
BOULDER, CO 80301